



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/453,327	12/02/99	HEENAN	056-9061-1

MM92/1011

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PHAN EXAMINER

ART UNIT 2

PAPER NUMBER

10/11/01

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/453,327

Applicant(s)

Heenan et al

Examiner

James Phan

Art Unit

2872



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 24, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-94 is/are pending in the application.
- 4a) Of the above, claim(s) 14-17, 19-25, 27, 28, and 31-90 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 1-11, 18, 26, 29, 30, and 91-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. The withdrawal of claims 18 and 91-93 has been reconsidered. Claims 18 and 91-93 have been rejoined with the elected invention.
2. Claims 14-17, 19-25, 27-28, 31-90 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

Terminal Disclaimer

The Terminal Disclaimer (TD) filed 4/9/01 is not proper because the TD is directed to particular claims, which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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J.P. 4. Claims 1-4, 11, ~~13~~ and 94 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-4 of U.S. Patent No. 6015214.

J.P. In re claims 1, 4, 11, ~~13~~ and 94 although the conflicting claims are not identical, they are not patentably distinct from each other because every limitation recited in application claims is disclosed in the patent claims.

In re claims 2 and 3 although the patent claims 1, 3 and 4 does not recite that the array of microcubes of an article is retroreflective or the article comprises a retroreflective sheeting, the use of an array of microcubes for a retroreflective article/sheeting is well known in the art (see Heenan '090, Jungersen '790). Thus, it would have been obvious to one skilled in the art to use array of microcubes as recited in the patent claims for a retroreflective article/sheeting for retroreflecting light.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-11, 18 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Jungersen.

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Jungersen discloses a retroreflective sheeting comprising triangular microcubes which are. ^{not hexagonal}
See Figs. 9 and 15.

In re claim 8 the material selected for the retroreflective sheeting is conventional and thus, it is inherently disclosed in Jungersen.

In re claims 9 and 10 the method of forming the microcubes does not make the microcubes patentably distinct from the microcubes disclosed in Jungersen.

In re claims 29-30 the recited feature is each of the claims is conventional and thus, it is inherently disclosed in Jungersen.

6. Claims 1-11, 18, 26, 29-30 and 91- 94 are rejected under 35 U.S.C. 102(b) as being anticipated by Heenan '090. See Figs. 8 and 10-12 and the accompanying text.

In re claims 29-30 the recited feature is each of the claims is conventional and thus, it is inherently disclosed in the Heenan patent.

In re claims 18 and 91-93 Figs. 1-2 and the accompanying text inherently meet the claimed features.

Applicants have traversed the above rejection by arguing that the Heenan patent is not enabling and thus does not anticipate the claimed invention. Declarations under 37 CFR Section 132 are provided for supporting applicants argument. The declarations have been fully considered; however, there are not much weight given to the declarations because all the patents are assumed to be valid; and thus, the argument has not been found persuasive.

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Allowable Subject Matter

7. Claim 12 is allowed.

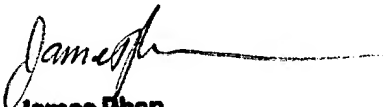
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Phan whose telephone number is (703) 308-4810. The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Phan, J.

October 8, 2001


James Phan
Primary Examiner